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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/750,792

01/03/2004

Jeff Scott Eder

VM-67

1490

53787

7590

06/17/2008

ASSET TRUST, INC.  
2020 MALTBY ROAD  
SUITE 7362  
BOTHELL, WA 98021

EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

06/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/750,792	<b>Applicant(s)</b> EDER, JEFF SCOTT	
	<b>Examiner</b> SIEGFRIED E. CHENCINSKI	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 175-197 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 175-197 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/03/04, 9/01/04, 9/08/04, 1/07/05, 5/10/05,</u>              | 6) <input type="checkbox"/> Other: _____                          |
| <u>10/05/05, 2/28/06, 8/03/07, 11/22/07.</u>   |   |



## DETAILED ACTION

### *Specification*

#### 1. OBJECTION

The abstract of the disclosure is objected to because it contains reference marks to the specification and the drawings.

Applicant is requested to remove the reference marks.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**2. Claims 175-187 and 193-197 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

Claims 175-197 recite a computer implemented method or process and storage device for determining the relevance of a key word. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)); *In re Comiskey*, 499 F.3d 1365 (Fed. Cir. 2007). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Applicant is advised to satisfy the statutory requirements for the claims. Applicant is also advised not to add any new matter to the specification or the claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**3. Claims 175-197 are rejected under 35 U.S.C. 112, first paragraph,** as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims limitations language in light of the specification is too general in order for an ordinary practitioner to specifically know what the invention is and to be able to apply it in a specific manner. The data inputs have no concrete basis and are purely subjective, as are the keywords. Also subjective are the user inputs. The expression “common schema” is absent in the specification so that a practitioner would be forced to invent his own definition for such a common schema. Further, the very nature of the problem presented in the Background section and the description of the invention in the summary make any solution unique, arbitrary and indefinite. All inputs are forced to be unique and subjective according to the assumptions and biases of judgment of each user. Therefore, there is no objective answer possible. All solutions to the process of this invention are guaranteed to be unique and highly subjective. The search results will accordingly be unique to every search. No two ordinary practitioners of the art working independently would be capable of replicating the results of implementing this invention. For purposes of examination the examiner is forced to make prior art search assumptions in order to locate prior art which the broadest reasonable interpretation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**4. Claims 175-197 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims limitations language in light of the specification is too general in order for an ordinary practitioner to specifically know what the invention is and to be able to apply it in a specific manner. The data inputs have no concrete basis and are purely subjective, as are the keywords. Also subjective are the user inputs. The expression "common schema" is absent in the specification so that a practitioner would be forced to invent his own definition for such a common schema. Further, the very nature of the problem presented in the Background section and the description of the invention in the summary make any solution unique, arbitrary and indefinite. All inputs are forced to be unique and subjective according to the assumptions and biases of judgment of each user. Therefore, there is no objective answer possible. All solutions to the process of this invention are guaranteed to be unique and highly subjective. The search results will accordingly be unique to every search. No two ordinary practitioners of the art working independently would be capable of replicating the results of implementing this invention. For purposes of examination the examiner is forced to make prior art search assumptions in order to locate prior art which the broadest reasonable interpretation.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 175-181 & 183-197 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Pant et al. (UA patent 6,012,0563, hereafter Pant) in view of Sandretto (US Patent 5,812,988).

**Re. Claims 175, 183, 188 and 193**, with claim 193 as exemplary, Pant discloses a computer implemented keyword relevance method, storage device and system, comprising:

- integrating a plurality of data from a plurality of organization related systems, user input, an Internet and one or more external databases in accordance with a common schema (user input – Col. 1, ll. 54-55; Fig. 1, 108; Fig. 2, 108; Fig. 3, 152; Internet and external databases – Col. 3, ll. 14-32; a common schema is an obvious required factor since that is an implicit requirement for doing a search which has to be organized instead of being non-directional and meaningless, since any organized search will have a focused goal, i.e. a common schema;
- searching for a plurality of keywords on the Internet and in one or more external databases (col. 3, ll. 14-32),
- storing a location for each identified keyword (Fig. 3, 172; Fig. 4, 206),
- counting and classifying each stored keyword (Col. 1, ll. 56-62; Fig. 3, 168, 174, 176, 180),
- creating one or more keyword performance indicators (Fig. 3, 158, 166),

While Pant implies the integration of a plurality of data by the user in order to formulate his search, and then teaching the integration of data through the relevancy oriented search process, Pant does not explicitly disclose “integrating a plurality of data from a plurality of organization related systems”, However, Sandretto discloses integrating a plurality of data from a plurality of organization related systems (Abstract – ll. 1-2; Col. 8, l. 52 – Col. 9, l. 39; portfolio generation – Col. 8, ll. 58, 61, integrating data from a plurality of organization related systems – Col. 8, 61—Col. 9, l. 19).

Pant does not explicitly disclose

- developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators, and

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- using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization where a plurality of keywords and classification information are obtained from user input.

However, Sandretto discloses a model of organizational financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators making use of user input (Col. 8, l. 52 – Col. 9, l. 39). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Pant for conducting relevance search with the art of Sandretto for developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators where a plurality of keywords and classification information are obtained from user input.

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Pant with the disclosures of Sandretto in order to develop a computer implemented keyword relevance method, motivated by the desire to provide a method for estimating asset risks and values (Sandretto, Col. 8, ll. 52-53).

**Re. Claims 176, 184, 189 & 194; 177 & 185; 180; & 181, 187, 192 & 197, the following limitations are not explicitly disclosed by Pant:**

**Re. Claims 176, 184, 189 & 194**, wherein at least some data are pre-specified for integration and conversion

**Re. Claims 177 & 185**, wherein a plurality of integrated enterprise data are stored in an application database in accordance with a common schema.

**Re. Claims 180**, wherein a data processing method further comprises storing a plurality of converted data in one or more tables to support organization processing.

**Re. Claims 181, 187, 192 & 197**, wherein each keyword maps to the common schema.

However, **Re. Claims 176, 184, 189 & 194; 177 & 185; 180; & 181, 187, 192 & 197**, these steps would have been obvious to the ordinary practitioner at the time of Applicant's invention because they are logical elements of a computer automated search process.



**Re. Claims 178, 185, 190 & 195,** Pant does not explicitly disclose wherein a plurality of organization related systems are selected from the group consisting of advanced financial systems, basic financial systems, alliance management systems, brand management systems, customer relationship management systems, channel management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource planning systems (ERP), material requirement planning systems (MRP), scheduling systems, supply chain systems, quality control systems, purchasing systems, risk management systems and combinations thereof. However, selecting a plurality of these related systems would have been obvious to the ordinary practitioner from the disclosure of Sandretto, for example capital asset systems, accounts receivable systems, accounts payable systems, inventory systems, etc.. (Col. 8, l. 52 – Col. 9, l. 19). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Pant with the disclosures of Sandretto in order to develop a computer implemented keyword relevance method, motivated by the desire to provide a method for estimating asset risks and values (Sandretto, Col. 8, ll. 52-53).

**Re. Claims 179, 186, 191 & 196,** Pant does not explicitly disclose wherein a common schema identifies data designations selected from the group consisting of components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof. However, a common schema which identifies data designations such as components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof would have been obvious to the ordinary practitioner from the disclosure of Sandretto, including components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof (Col. 8, l. 52 – Col. 9, l. 19). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of

Applicant's invention to have combined the disclosures of Pant with the disclosures of Sandretto in order to develop a computer implemented keyword relevance method, motivated by the desire to provide a method for estimating asset risks and values (Sandretto, Col. 8, ll. 52-53).

**6. Claim 182 is rejected under 35 U.S.C. 103(a)** as being unpatentable over Pant et al. (UA patent 6,012,0563, hereafter Pant) in view of Sandretto (US Patent 5,812,988) as applied to claim 175 above, and further in view of Official Notice.

**Re. Claims 182**, wherein the program storage device comprises one or more intelligent agents (The examiner takes Official Notice that the use of intelligent agents were well known in the computer art at the time of Applicant's invention).

### ***Conclusion***

**7.** Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Alexander Kalinowski, can be reached on (571) 272-6771.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks, Washington D.C. 20231***

or Faxed to (571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

or Faxed to (571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

June 9, 2008

/Narayanswamy Subramanian/  
Primary Examiner, Art Unit 3691